



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|--------------------------------|------------------------|
| 09/903,534 | 07/13/2001 | Hiroshi Sakurai | 1081.1125 | 2164 |
| 21171 | 7590 | 10/18/2007 | | |
| STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005 | | | EXAMINER VAN BRAMER, JOHN W | |
| | | | ART UNIT 3622 | PAPER NUMBER |
| | | | MAIL DATE 10/18/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 09/903,534 | Applicant(s) SAKURAI, HIROSHI | |
| | Examiner John Van Bramer | Art Unit 3622 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed on July 30, 2007, cancelled no claims. Claims 1, 9, 10, 11, 14, 17, 18, 19, 22 and 23 have been amended and new Claim 25 has been added. Thus the currently pending claims are Claims 1-25.

Claim Objections

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

The new amendment has introduced a second Claim 24. In order to prosecute the amendment the examiner has considered that the newly submitted claim was intended to be Claim 25. .

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 3622

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldhaber et al. (U.S. Patent Number: 5,794,210).

Claims 1, 22, and 23. Goldhaber discloses a method for distributing advertisements to a user through a computer network, comprising the steps of:

- a. Storing advertiser registration information including advertisement information for goods and/or services provided by an advertiser according to a registration request by said advertiser (Col 14, lines 17-40; and Col 15, lines 17-30)
- b. Storing user registration information including search conditions for goods and/or services specified by said user according to a registration request by said user (Col 12, line 59 through Col 13, line 47)
- c. Extracting advertisement information matching said search conditions from among said stored advertisement information. (Col 14, lines 59-67)
- d. Distributing said extracted advertisement information to said user. (Col 14, lines 59-67)
- e. Judging a level of contribution, of a questionnaire regarding the advertisement information response, to said advertiser, the level of contribution having plurality of values. (Col 7, lines 63-67; Col 11, lines 32-43; Col 17, lines 33-63; and Col 23, lines 1-3) (Goldhaber describes the user receiving additional

compensation for answering a question regarding the users interest in having the merchant contact them. When the user answers in the affirmative additional information is supplied to the merchant (increased contribution), and additional compensation is provided.)

- f. Determining a reward amount for each questionnaire regarding the advertisement information response in proportion to the level of contribution. (Col 7, lines 63-67; Col 11, lines 32-43; Col 17, lines 33-63; and Col 23, lines 1-3)

Claim 2. Goldhaber discloses the method for distributing advertisements according to claim 1, wherein said computer network is the Internet; and said extracted advertisement information is distributed as an Internet home page screen to a terminal of said user connected to the Internet. (Col 7, lines 28-47; and Col 9, lines 33-67)

Claim 3. Goldhaber discloses the method for distributing advertisements according to claim 1, wherein said computer network is the Internet; and said extracted advertisement information is distributed as electronic mail to the terminal of said user connected to the Internet. (Col 6, lines 3-22; and Col 9, lines 33-67)

Claim 4. Goldhaber discloses the method for distributing advertisements according to claim 1, comprising:

- a. Storing questionnaires relating to goods and/or services corresponding to said distributed advertisement information and relating to advertisers providing these goods and/or services. (Col 16, lines 6-17)
- b. Distributing said questionnaires to said users (Col 16, lines 6-17)
- c. Receiving and storing responses to said questionnaires from said users. (Fig 12, and Col 16, lines 6-17)

Claim 5. Goldhaber discloses the method for distributing advertisements according to claim 4, wherein said questionnaires include one of a pre-purchase questionnaires for said user to respond before said user purchases the goods and/or services corresponding to said distributed advertisement information, and a post-purchase questionnaires for said user to respond after said user purchases the goods and/or services corresponding to said distributed advertisement information. (Col 16, lines 6-17; and Col 18, lines 47-59) (Goldhaber does not limit the time frame in which interaction with the advertisement disclosed in these sections occurs. Therefore, interactions such as rating the ads are interpreted by the Examiner to be capable of being performed both pre-purchase and post-purchase.)

Claim 6. Goldhaber discloses the method for distributing advertisements according to claim 5, wherein said pre-purchase questionnaires include questions for gathering impressions said user has of said goods and/or services, or of the advertisers providing these goods and/or services, before said user purchases the goods and/or

services corresponding to said distributed advertisement information. (Col 16, lines 6-17; and Col 18, lines 47-59) (Goldhaber does not limit the time frame in which interaction with the advertisement disclosed in these sections occurs. Therefore, interactions such as rating the ads are interpreted by the Examiner to be capable of being performed both pre-purchase and post-purchase.)

Claim 7. Goldhaber discloses the method for distributing advertisements according to claim 5, wherein said post-purchase questionnaires include questions for gathering feelings and opinions said user has of said goods and/or services, or of the advertisers providing these goods and/or services, after said user purchases the goods and/or services corresponding to said distributed advertisement information. (Col 16, lines 6-17; and Col 18, lines 47-59) (Goldhaber does not limit the time frame in which interaction with the advertisement disclosed in these sections occurs. Therefore, interactions such as rating the ads are interpreted by the Examiner to be capable of being performed both pre-purchase and post-purchase.)

Claim 8. Goldhaber discloses the method for distributing advertisements according to claim 4, wherein a prescribed reward amount is paid to users who respond to said questionnaires. (Col 16, lines 6-17)

Claim 9. Goldhaber discloses the method for distributing advertisements according to claim 1, wherein the level of contribution is calculated by using parameters

Art Unit: 3622

corresponding to importance, credibility, and novelty of the questionnaire regarding the advertisement information response. (Col 7, lines 63-67; Col 11, lines 32-43; Col 17, lines 33-63; and Col 23, lines 1-3) (Goldhaber verifies the credibility of the response by checking to see if its completed and whether the account is "bad" or not. If the response it bad it is novel. Additionally, Goldhaber discloses that the user receives additional compensation by agreeing to submit important information such as direct contact information.)

Claim 10. Goldhaber discloses the method for distributing advertisements according to claim 4, wherein results of compiling said questionnaire regarding the advertisement information responses for a specific advertiser or the goods and services provided by the advertiser are distributed to said specific advertiser. (Fig 12; and Col 17, lines 33-63)

Claim 11. Goldhaber discloses the method for distributing advertisements according to claim 4, wherein advertisement information matching said search conditions is extracted on the basis of said questionnaire regarding the advertisement information responses. (Col 17, line 64 – Col 18, line 33)

Claim 12. Goldhaber discloses the method for distributing advertisements according to claim 1, comprising:

- a. Receiving questions, regarding goods and/or services corresponding to said distributed advertisement information or regarding the specific advertiser providing these goods and/or services, from a specific user. (Col 15, lines 1-6; and Col 16, line 64 through Col 18, line 59)
- b. Storing said questions and then forwarding the questions to said specific advertiser. (Col 15, lines 1-6; and Col 16, line 64 through Col 18, line 59)
- c. Receiving a response to said questions from said specific advertiser. (Col 15, lines 1-6; and Col 16, line 64 through Col 18, line 59)
- d. Storing the response to said questions and then distributing the response to the questions to said specific user. (Col 15, lines 1-6; and Col 16, line 64 through Col 18, line 59)

Claim 13. Goldhaber discloses the method for distributing advertisements according to claim 12, comprising:

- a. Setting a response deadline for the response to said questions for said specific advertiser. (Col 4, lines 47-62) (An auction inherently includes a deadline for auction completion thereby urging bidders to respond.)
- b. Urging said specific advertiser to respond to said questions when a response to said questions is not received by said response deadline. (Col 4, lines 47-62) (An auction inherently includes a deadline for auction completion thereby urging bidders to respond.)

Claim 14. Goldhaber discloses an apparatus for distributing advertisements to users through a computer network, comprising:

- a. A memory unit for storing advertiser registration information, including advertisement information for goods and/or services provided by an advertiser, according to a registration request by the advertiser; and storing user registration information including search conditions for goods and/or services specified by said user according to a registration request by said user. (Col 12, line 59 through Col 13, line 47; Col 14, lines 17-40; and Col 15, lines 17-30)
- b. A control unit for extracting advertisement information, matching said search conditions, from among said stored advertisement information; and distributing said extracted advertisement information to said user. (Col 14, lines 59-67)
- c. Wherein said control unit judges a level of contribution, of a questionnaire regarding the advertisement information response, to said advertiser, and determines a reward amount for each questionnaire regarding the advertisement information in proportion to the level of contribution, in the case where a prescribed reward amount is paid to users who respond to questionnaires, the level of contribution having a plurality of values. (Col 7, lines 63-67; Col 11, lines 32-43; Col 17, lines 33-63; and Col 23, lines 1-3)
(Goldhaber describes the user receiving additional compensation for

answering a question regarding the users interest in having the merchant contact them. When the user answers in the affirmative additional information is supplied to the merchant (increased contribution), and additional compensation is provided.)

Claim 15. Goldhaber discloses the apparatus for distributing advertisements according to claim 14, wherein said memory unit stores questionnaires relating to goods and/or services corresponding to said distributed advertisement information and relating to advertisers providing these goods and/or services; and said control unit distributes said questionnaires to said users, receives responses to said questionnaires from said users, and stores responses to the questionnaires in said memory unit. (Fig 12, and Col 16, lines 6-17)

Claim 16. Goldhaber discloses the apparatus for distributing advertisements according to claim 15, wherein said questionnaires include pre-purchase questionnaires for said user to respond before said user purchases the goods and/or services corresponding to said distributed advertisement information, or post-purchase questionnaires for said user to respond after said user purchases the goods and/or services corresponding to said distributed advertisement information. (Col 16, lines 6-17)

Claim 17. Goldhaber discloses the apparatus for distributing advertisements

Art Unit: 3622

according to claim 14, wherein the level of contribution is calculated by using parameters corresponding to importance, credibility, and novelty of the questionnaire regarding the advertisement information response. (Col 7, lines 63-67; Col 11, lines 32-43; Col 17, lines 33-63; and Col 23, lines 1-3) (Goldhaber verifies the credibility of the response by checking to see if its completed and whether the account is "bad" or not. If the response it bad it is novel. Additionally, Goldhaber discloses that the user receives additional compensation by agreeing to submit important information such as direct contact information.)

Claim 18. Goldhaber discloses The apparatus for distributing advertisements according to claim 15, wherein said control unit compiles said questionnaire regarding the advertisement information responses for a specific advertiser or the goods and/or services provided by the advertiser and distributes the compiled results to said specific advertiser. (Fig 12; and Col 17, lines 33-63)

Claim 19. Goldhaber discloses The apparatus for distributing advertisements according to claim 15, wherein said control unit extracts advertisement information, matching said search conditions on the basis of said questionnaire regarding the advertisement information responses. (Col 17, line 64 through Col 18, line 33)

Claim 20. Goldhaber discloses The apparatus for distributing advertisements according to claim 14, wherein, upon receiving questions, from a specific user,

regarding goods and/or services corresponding to said distributed advertisement information or regarding the specific advertiser providing these goods and/or services, said control unit stores said questions in said memory unit and then forwards the questions to said specific advertiser; and upon receiving the response to said questions from said specific advertiser, said control unit stores the response to said questions in said memory unit and then distributes the response to the questions to said specific user. (Col 15, lines 1-6; and Col 17, line 64 through Col 18, line 59)

Claim 21. Goldhaber discloses The apparatus for distributing advertisements according to claim 20, wherein said control unit sets a response deadline for the response to said questions for said specific advertiser, and urges said specific advertiser to respond to said questions when a response to said questions is not received by said response deadline. (Col 4, lines 47-62)

Claim 24: Goldhaber discloses a method determining compensation for viewing of advertisements, comprising: determining from a contribution level a consumer makes when answering a survey about a product in response to the consumer viewing an advertisement for the product and paying a reward in proportion to the contribution level determined for each survey which the consumer answers. (Col 7, lines 63-67; Col 11, lines 32-43; Col 17, lines 33-63; and Col 23, lines 1-3)
(Goldhaber describes the user receiving additional compensation for answering a

question regarding the users interest in having the merchant contact them. When the user answers in the affirmative additional information is supplied to the merchant (increased contribution), and additional compensation is provided.)

Claim 25: Goldhaber discloses a method of rewarding a user for answering a questionnaire regarding advertising information, comprising: judging a level of contribution to the questionnaire regarding advertising information responded to by a user; and rewarding the user based on the judgment of the level of contribution, the level of contribution having a plurality of values. (Col 7, lines 63-67; Col 11, lines 32-43; Col 17, lines 33-63; and Col 23, lines 1-3) (Goldhaber describes the user receiving additional compensation for answering a question regarding the users interest in having the merchant contact them. When the user answers in the affirmative additional information is supplied to the merchant (increased contribution), and additional compensation is provided.)

Response to Arguments

5. Applicant's arguments filed March 14, 2007 have been fully considered but they are not persuasive.
 - a. The applicant argues that Goldhaber does not teach or suggest determining a reward amount for each questionnaire response based on the level of contribution. However, Goldhaber specifically states in Col 17, lines 34 – 63 that the attention broker server determines whether the user's interaction with the

advertisement was adequate based upon interaction data and paying consumers based upon the determination of adequacy. The determination of adequacy is based upon data collected regarding the users interaction with the advertisement. Col 11, lines 32-43, further clarify that interaction data includes answering appropriate questions or providing requested information. Therefore, the current limitation of the claims have been met because the reward amount is determined based upon the interaction of the customer with the advertisement. If the customer interacts appropriately they receive the reward. If the customer does not interact appropriately they receive a reward of zero. While the applicant may intend that there be a determination of additional reward amount between zero and the full amount, such limitations are not positively claimed in the independent claims. However, in an effort to further the prosecution of the case, the examiner points to Col 7, lines 48 –67, which disclose the customer selecting to view an advertisement and receiving compensation for interacting with the advertisement. The cited section further discloses that during interaction with the advertisement the customer can earn an additional reward by agreeing to provide the merchant with her identity. Thus three reward levels are disclosed. The customer can earn a reward of zero if they do not interact with the ad appropriately, the customer can earn a reward for interacting with the advertisement appropriately, or the customer can earn a reward for interacting with the advertisement appropriately plus an additional reward for providing identity information. In regards to the newly amended claims inclusion of the

phrase "regarding the advertisement information", the customers agreement while viewing the advertisement to provide their identity information constitutes a level of contribution, of a questionnaire regarding the advertisement information response and as such satisfies the limitations of the claim.

- b. The applicant argues regarding claim 5, that Goldhaber only discloses pre-purchase questionnaires. The examiner agrees that Goldhaber discloses pre-purchase questionnaires but disagrees with the assertion that Goldhaber does not disclose post-purchase questionnaires. The Goldhaber reference targets and sends advertisements and questionnaires based upon the users account history (Col 12, lines 14-37). Since the account history includes purchases, post-purchase questionnaires are also sent. Regardless, the claim as currently written requires that only *one of* a pre-purchase questionnaire and a post-purchase questionnaire be sent. As the applicant admits that Goldhaber discloses pre-purchase questionnaires, the limitations of claim 5 as currently written have been met.
- c. The applicant argues, regarding claim 9, that Goldhaber fails to teach or suggest wherein the level of contribution is calculated by using parameters corresponding to importance, credibility, and novelty. The applicant has put forth no argument regarding why Goldhaber fails to teach the limitations of claim 9 other than the mere assertion that it does not. Therefore, the examiner must maintain the rejection set forth in the Office Action dated April 30, 2007 where it specifically describes the use of such parameters in Goldhaber.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

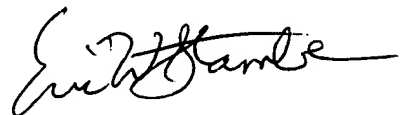
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is (571) 272-8198. The examiner can normally be reached on 6am - 4pm Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


jvb


ERIC W. STAMBER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600